

Application No. 09/591,035
Amendment Dated June 7, 2004
Reply to the Final Office Action of February 6, 2004

REMARKS/ARGUMENTS

Claims 1, 5, 6, 9, 13, 14, 17, 21, and 22 have been amended. No new claims have been added. No claims have been canceled. Claims 1-24 remain pending in this application. Reexamination and reconsideration of the application as amended are respectfully requested.

Rejections under 35 U.S.C. § 103 of Claims 1-24

The Examiner rejected claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over *Helgeson et al.*, U.S. Patent Application No. 2002/0073236, in view of *O'Brien et al.*, U.S. Patent No. 6,351,776. Applicants respectfully traverse this rejection for the reasons set forth below.

Independent claims 1, 9, and 17 have been amended. Applicants therefore respectfully request that the Examiner reconsider and withdraw the 35 U.S.C. § 103(a) rejections of claims 1, 9, and 17.

Relative to dependent claims 2-8, 10-16, and 18-24, these dependent claims depend from independent claims 1, 9, and 17, respectively. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Since these dependent claims depend from independent claims

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1, 9, and 17, and Applicants believe they have successfully traversed the Examiner's rejection of independent claims 1, 9, and 17, Applicants respectfully request that the Examiner reconsider and withdraw the rejections of dependent claims 2-8, 10-16, and 18-24.

The Examiner rejected independent claims 1, 9, and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Helgeson et al.* in view of *O'Brien et al.*. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP 2143, Basic Requirements of a *Prima Facie* Case of Obviousness.

The Examiner's rejection of independent claims 1, 9, and 17 under 35 U.S.C. § 103(a) fails to establish a *prima facie* case of obviousness. Relative to the first criteria that there must be some suggestion or motivation to modify the reference or to combine reference teachings found in the prior art, not in Applicants' disclosure, the Examiner asserts a suggestion or motivation to modify the reference *Helgeson et al.* which is found in the Applicants' disclosure.

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The suggestion or motivation to modify the reference alleged by the Examiner would provide for the files to be available worldwide through the Internet and provide for means by which files and other data may be stored on the Internet and made available worldwide through the Internet.

However, Applicants' disclosure reads:

“As will be appreciated upon reference to the foregoing, it is often desirable for a user to link a transaction-based application on the mainframe 18 to the internet 32 and/or World Wide Web (web), where the transaction-based application was not originally designed for web or internet based transactions.” (p. 10, lines 23-26, Applicants' Disclosure)

Thus, the Examiner's rejection of independent claims 1, 9, and 17 fails to establish a *prima facie* case of obviousness as it does not establish a suggestion or motivation to modify the reference or to combine reference teachings not found in Applicants' disclosure. Applicants therefore respectfully request that the Examiner reconsider and withdraw the 35 U.S.C. § 103(a) rejections of independent claims 1, 9, and 17.

Relative to dependent claims 2-8, 10-16, and 18-24, these dependent claims depend from independent claims 1, 9, and 17, respectively. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Since these dependent claims depend from independent claims 1, 9, and 17, and Applicants believe they have successfully traversed the Examiner's rejection of

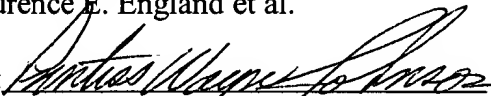
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independent claims 1, 9, and 17, Applicants respectfully request that the Examiner reconsider and withdraw the rejections of dependent claims 2-8, 10-16, and 18-24.

Conclusion

Applicants therefore respectfully request that the Examiner reconsider all currently outstanding objections and rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this Application, the Examiner is invited to telephone the undersigned at the number provided. Prompt and favorable consideration of this Response is hereby solicited.

Respectfully submitted,
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